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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,717	07/17/2003	Paul D. Forsythe	FORS-0968	2941

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SCHMEISER OLSEN & WATTS  
18 E UNIVERSITY DRIVE  
SUITE # 101  
MESA, AZ 85201

EXAMINER

GRAHAM, MARK S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/622,717

Applicant(s)

FORSYTHE ET AL.

Examiner

Mark S. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.  
4a) Of the above claim(s) 69 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-46, 54, 56-58, 65, 66 and 68 is/are allowed.
- 6) ☒ Claim(s) 1-9, 28-38, 47, 49-53, 55, 59-64, 67, 70 and 71 is/are rejected.
- 7) ☒ Claim(s) 10-27 and 48 is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Newly submitted claim 69 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The combination bat as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because other tubes may be used in the bat's construction. The subcombination has separate utility such as a table leg.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 69 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 2-8, 38, 48, 55, 59-62, and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, lines 6 and 7, "the end cap" lacks proper antecedent basis.

In claims 38 and 48, line 3, "the center tube" lacks proper antecedent basis.

In claim 55, line 5, "the transition piece" lacks proper antecedent basis.

In claim 59, line 7, "the center tube" lacks proper antecedent basis.

In claim 70, line 5, "knob end" lacks proper antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 28, 59, 60, are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan.

Regarding claim 9, Ryan's center tube 6 may be considered the ballast.

Claim 28 is rejected for the reasons set forth in the previous action. In response to applicant's comments the structure at either end of Ryan's barrel on the tube axially abuts it and serves to clamp it on the tube in a removable fashion.

Concerning claims 59 and 60, Ryan's element 114 may be considered the end plug and to fasten such to the tube one would turn it at least 90 degrees.

Claims 37 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Muhlhausen.

Note Muhlhausen's transition piece which includes concentric connectable parts 24 and 26.

Claim 71 is rejected under 35 U.S.C. 102(b) as being anticipated by Owen.

Note Owen's transition piece 12, ballast 15, engagement structure 27, an end cap engagement structure 20.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Owen for the reasons set forth in the previous action and in the claim 28 rejection above. In response to applicant's comments Owen teaches the use of non-structural ballast 15 for the purpose of weighting and balancing the bat as desired. It would have been obvious to one of ordinary skill in the art to have used such on Ryan's bat for the same reason. The examiner finds no reason that such would "destroy" Ryan's reference. The end structure of Ryan's bat is removable and even were it not Owen teaches how to provide end structure to allow for insertion of ballast material.

Regarding the weight of Ryan's bat applicant has not provided any evidence to support his assertions of its weight. Moreover, Owen specifically teaches that bats under 30 ounces may be constructed.

Claims 35, 36, 49-52, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Muhlausen for the reasons set forth in the previous action.

In response to applicant's arguments the examiner finds no teaching that Ryan's bat is not designed for dismantling. Indeed, its very construction using threaded fasteners to attach its component parts suggests exactly the opposite.

Second Muhlhausen's bat clearly discloses barrels as such are known and used in the art. The fact that Muhlhausen's barrels are narrower for training purposes does not diminish this fact. Even if one wishes to simply consider them contact surfaces then they are applicable to Ryan's contact surface in the same manner. The point of the rejection remains the same. The prior art teaches the use of interchangeable hitting portions of the bat for training purposes.

In response to applicant's third argument the examiner has never suggested bodily incorporation of Muhlhausen's contact surfaces. The ordinarily skilled artisan is not considered to work in a vacuum and is presumed to have some modicum of engineering ability. One applying Muhlhausen's teaching to Ryan's bat would obviously have just varied the barrel portion of Ryan's bat.

Regarding applicant's fourth point Ryan teaches all of the argued features.

Applicant's further arguments as to claims 49 and 52 have been considered but are believed to be addressed in the response above and the original rejection.

Claims 53, 55, 63, 64, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan.

Regarding claim 53, twisting Ryan's center tube relative to the barrel would have been obvious to the ordinarily skilled artisan in an attempt to properly fit the pieces together as the bat parts were lined up for final assembly/fastening.

Concerning claims 55 and 63, Ryan discloses the claimed device with the exception of the "nut" or "blocking nut". Ryan uses a set screw to hold the transition piece in place. However, the examiner takes official notice that nuts or blocking nuts are another commonly known fastener. Such would obviously have been suitable to the ordinarily skilled artisan constructing Ryan's bat if such a fastener were more readily available.

Regarding claim 63, Ryan's element 114 is an end plug with an enlarged head.

Concerning claims 64 and 70, Ryan does not indicate which end of the barrel the tube is inserted through during its construction although it could obviously have been done in either fashion. Inserting the tube through the top end of the barrel would have resulted in its being

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inserted into the barrel before the transition piece. Such a step would obviously have been up to the ordinarily skilled artisan depending on what was considered most efficient during assembly.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13-25, 28, 35, 36, 67, and 70 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/434,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because removal of the additionally claimed elements with their corresponding loss of function would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 9, 11, 26, 28, 29-34, and 49-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/434,553 in view of Owens. The claims are met by the '553 claims with the exception of the ballast. However, as disclosed by Owens such is known in the

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art. It would have been obvious to one of ordinary skill in the art to have used such on the bat of the instant claims to weight it as desired.

This is a provisional obviousness-type double patenting rejection.

No terminal disclaimer has been received.

Claims 39-46, 54, 56-58, 65, 66, and 68 are allowed.

Claims 10-27 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 2 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 3-8, 38, 61, and 62 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed 6/24/04 have been fully considered but they are not persuasive.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

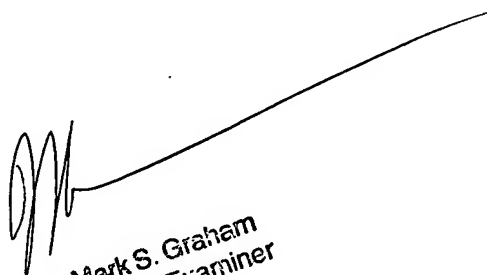


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG  
10/12/04



Mark S. Graham  
Primary Examiner